

REMARKS**Summary of the Office Action**

In the Office Action, the drawings and specification are objected to for minor informalities.

Claims 1, 3, 4, 6, and 7 stand rejected under 35 U.S.C. § 102(b) as being anticipated, by U.S. Patent No. 3,212,632 to *Baum, et al.*

Claims 1-4 stand rejected under 35 U.S.C. § 102(b) as being anticipated by German Patent No. 296 17 764 to *Gmeiner*.

Claims 1 and 5 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over European Patent No. 0 053 828 to *Signode Corporation* ("Signode") in view of *Baum, et al.*

Summary of the Response to the Office Action

Applicants have amended claim 1 and added new claim 8. Accordingly, claims 1-8 are pending for further consideration.

Applicants have also amended the drawings and the specification in accordance with Examiner's helpful suggestions. A Submission of Corrected Formal Drawings is being filed concurrently herewith.

All Claims are Allowable

Claims 1, 3, 4, 6, and 7 stand rejected under 35 U.S.C. § 102(b) as being anticipated, by U.S. Patent No. 3,212,632 to *Baum, et al.* Claims 1-4 stand rejected under 35 U.S.C. § 102(b) as being anticipated by German Patent No. 296 17 764 to *Gmeiner*. Applicants respectfully traverse the rejection for at least the following reasons.

Applicants respectfully submit that newly amended claim 1 is not anticipated by either

Baum, et al. or *Gmeiner*. Applicants contend that the independent claim 1 recites a combination of features such as “plural sheets of the stick-type connected nails . . . superposed in a multiple loading-type nail magazine such that the vertical position of respective heads thereof is offset” that are not anticipated by either *Baum, et al.* or *Gmeiner*. The offset heads of the stick-type connected nails feature recited in independent claim 1, is not disclosed in either reference.

Baum, et al. and *Gmeiner* show bands or links, positioned about a quarter of the length of the nail from its end, that connect the nails together. The references do not disclose the stick-type connected nails superposed and offset from the other stick-type connected nails in the nail magazine. As such, neither reference can anticipate Applicants’ invention.

As pointed out in MPEP § 2131, a claim is anticipated by a prior art reference only if each and every element as set forth in the claim is found. *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051 (Fed. Cir. 1987). Therefore, Applicants respectfully assert that the rejection under 35 U.S.C. § 102(b) should be withdrawn because neither *Baum, et al.* nor *Gmeiner* teaches or suggests each feature of independent claim 1. Additionally, it is further respectfully submitted that dependent claims 2-8 are also allowable insofar as they recite the patentable combinations of features recited in independent claim 1, as well as reciting additional features that further distinguish over the applied prior art.

All Subject Matter Complies With 35 U.S.C. § 103(a)

Claims 1 and 5 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over European Patent No. 0 053 828 to *Signode Corporation* in view of *Baum, et al.* This rejection is respectfully traversed for at least the following reasons.

Applicants respectfully submit that the Office Action has not established a *prima facie* case of obviousness and therefore all rejections under 35 U.S.C. § 103(a) should be withdrawn. As pointed out in M.P.E.P. § 2143.03, "[t]o establish prima facie obviousness of a claimed invention, all the claimed limitations must be taught or suggested by the prior art". *In re Royka*, 409 F.2d 981, 180 USPQ 580 (CCPA 1974). *Signode*, whether alone or in combination, does not makeup for the above-mentioned deficiencies of *Baum et al.* *Signode* does not disclose the "plural sheets of the stick-type connected nails . . . superposed in a multiple loading-type nail magazine such that the vertical position of respective heads thereof is offset," features recited in claim 1. As such, *Signode* in view of *Baum et al.* cannot make the Applicants' invention obvious.

For at least these reasons, Applicants respectfully submit that claim 1 is allowable. Claims 2-8 are allowable at least because they recite the same combination of features as independent claim 1, as well as the additional features they recite that further distinguish them over the applied prior art. Accordingly, it is respectfully requested that all rejections under 35 U.S.C. § 103(a) be withdrawn.

CONCLUSION

In view of the foregoing, Applicants respectfully request reconsideration and the timely allowance of the pending claims. Should the Examiner feel that there are any issues outstanding after consideration of the response, the Examiner is invited to contact the Applicants' undersigned representative to expedite prosecution.

If there are any other fees due in connection with the filing of this response, please charge the fees to our Deposit Account No. 50-0310. If a fee is required for an extension of time under 37 C.F.R. §1.136 not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account.

Respectfully submitted,

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